

ROUTING FOR DECISIONS OF BOARD OF APPEAL

| | Initials | Date |
|--------------------------|--------------------|----------------|
| QAS | <u>MS</u> | <u>5/24/04</u> |
| Director | <u>[Signature]</u> | <u>5/26/04</u> |
| SPE | _____ | _____ |
| Examiner | _____ | _____ |
| Disposal Recorded by LIE | _____ | _____ |

| Date of Decision | Serial Number | Examiner | Art Unit | Affirmed | Reversed |
|------------------|-------------------|---------------|-------------|--------------------------------|--------------------------------|
| <u>5/10/04</u> | <u>09/421,676</u> | <u>Lerner</u> | <u>3611</u> | <input type="checkbox"/> 101 | <input type="checkbox"/> 101 |
| | | | | <input type="checkbox"/> 102 | <input type="checkbox"/> 102 |
| | | | | <input type="checkbox"/> 103 | <input type="checkbox"/> 103 |
| | | | | <input type="checkbox"/> 112 | <input type="checkbox"/> 112 |
| | | | | <input type="checkbox"/> other | <input type="checkbox"/> other |

****DUE DATE: JUNE 25, 2004

Comments: Remanded

37 CFR 1.196(a) needs a supplemental Examiner's answer.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MEMORANDUM

TO: GROUP 3611 DIRECTOR

**FROM: BOARD OF PATENT APPEALS AND
INTERFERENCES**

SUBJECT: ORDER REMANDING TO EXAMINER

**We are forwarding this application to
your Group for taking further action
consistent with the decision of the Board
remanding this appeal to the Primary Examiner.**

**Program & Resource Administrator
Board of Patent Appeals and Interferences
308-9797**

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

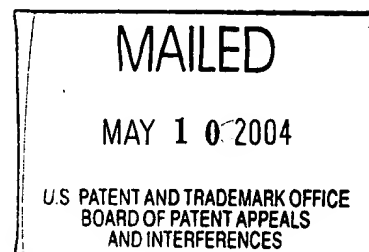
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNHARD GOTZ

Appeal No. 2004-1121
Application 09/421,676

ON BRIEF



Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner under the authority of 37 CFR 1.196(a) and MPEP § 1211 for action in accordance with the following comments.

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The appeal involves claims 1 through 19, 21 and 22, all of the claims remaining in this application. Claim 20 has been canceled.

Appellant's invention is directed to an industrial truck (e.g., a fork lift truck) wherein the improvement involves mounting the truck's internal combustion engine (4) on the rear weight (1) associated with and carried by the vehicle frame (3), instead of mounting the engine directly to the vehicle frame as is conventionally done. Appellant indicates on pages 1-2 of the specification that such mounting of the engine to the rear weight prevents the transmission of engine vibrations into other components of the truck and, in particular, into the vicinity of the operator's cab, because the large mass of the rear weight can be excited to vibrate only to a very small extent by the engine vibrations and because of the high internal damping of the gray cast iron conventionally used in making the rear weight. Appellant also notes that an added advantage of the above-noted engine mounting arrangement is that it permits pre-assembly of the internal combustion engine on the rear weight, which then allows the rear weight and internal combustion engine to be

connected in the form of a single assembly to the frame of the industrial truck. Independent claims 1, 21 and 22 are representative of the subject matter on appeal and read as follows:

1. An industrial truck, comprising:

a frame;

a rear weight separate from the frame connected to the frame; and

an internal combustion engine, wherein the internal combustion engine is mounted on the rear weight such that the rear weight is positioned between the engine and the frame such that vibrations from the engine are transmitted from the engine to the rear weight and from the rear weight to the frame.

21. An industrial truck, comprising:

a frame;

a rear weight separate from the frame and connected to the frame; and

an internal combustion engine fastened to the rear weight such that the internal combustion engine is carried on the industrial truck by the rear weight.

22. An industrial truck, comprising:

a frame;

a rear weight separate from the frame and connected to one end of the frame; and

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an internal combustion engine mounted on the rear weight by fastening means such that vibrations from the engine are transmitted to the rear weight by the fastening means, and such that the engine is connected to the frame by the rear weight.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|------------------------------|-----------|---------------|
| Wilkes, Jr., et al. (Wilkes) | 4,202,453 | May 13, 1980 |
| Wakana et al. (Wakana) | 6,085,858 | Jul. 11, 2000 |

Claims 1 through 19, 21 and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the examiner, the language "a rear weight separate from the frame and connected to the frame," present in each of the independent claims on appeal, is unclear and indefinite since the statement in itself is contradictory, because in the examiner's view an element can not be separate from a frame and connected to same.

Claims 1, 7, 21 and 22 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wilkes.

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Claims 2 through 6 and 8 through 19 additionally stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilkes in view of Wakana.

Dictionary semantics aside, on REMAND, we solicit a full response from the examiner to appellant's arguments bridging pages 6-7 of the brief (Paper No. 26) concerning the rejection of claims 1 through 19, 21 and 22 under 35 U.S.C. § 112, second paragraph. In that regard, we note that before the USPTO, when evaluating claim language during examination of an application, an examiner is required to give the terminology of the claims its broadest reasonable interpretation consistent with the specification, and to remember that the claim language cannot be read in a vacuum, but instead must be read in light of the specification as it would be interpreted and understood by one of ordinary skill in the pertinent art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

In the context of the rejection of claims 2 through 6 and 8 through 19 under 35 U.S.C. § 103(a) as being unpatentable over Wilkes in view of Wakana, we note that, in addition to a general argument that these claims are patentable due to their dependence from independent claim 1, appellant has also presented arguments in the paragraph bridging pages 12-13 of the brief that specific limitations set forth in claims 3, 6, 12, 13 and 14 are not taught or suggested in the prior art applied by the examiner, whether such prior art is considered alone or in combination. The only statement by the examiner with regard to these arguments (answer, page 9) is that "since these claims stand or fall with claim 2, these arguments have not been addressed."

Notwithstanding that, under certain circumstances, 37 CFR § 1.192(c)(7) permits "the Board" to select a single claim from a group of claims subject to a ground of rejection and decide the appeal as to that ground of rejection on the basis of that claim alone, we note that neither the Board nor the examiner should refuse to consider specific arguments presented in an appeal brief by an appellant directed to the separate patentability of enumerated claims. Thus, on REMAND, we solicit the examiner's response to the above-noted arguments directed to claims 3, 6,

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12, 13 and 14 on appeal and make note of the examiner's responsibility in any rejection under 35 U.S.C. § 103 to a) state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon, b) point out any difference between the rejected claims and the prior art relied upon, and c) explain how and why the claimed subject matter is rendered unpatentable over the applied prior art (i.e., would have been obvious to one of ordinary skill in the art at the time of appellant's invention based on the combined or collective teachings of the applied prior art).

A supplemental examiner's answer clarifying the issues discussed above would appear to be necessary and is hereby authorized. It follows that appellant should have an opportunity to respond to any such supplemental answer by way of a reply brief (see, 37 CFR § 1.193(b)(1)).

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This application, by virtue of its "special" status,
requires immediate action, see MPEP § 708.01 (Eighth Edition,
August 2001).

REMANDED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

Lawrence J. Staab

LAWRENCE J. STAAB
Administrative Patent Judge

Jeffrey V. Nase

JEFFREY V. NASE
Administrative Patent Judge

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William H. Logsdon
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818